



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/716,360      | 08/03/1999  | ROBERT JOHN MABBOTT  | 16286-702           | 5698             |

909 7590 12/04/2002  
PILLSBURY WINTHROP, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT PAPER NUMBER

1774

DATE MAILED: 12/04/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/716,360

Applicant(s)

MABBOTT ET AL.

Examiner

Michael E. Grendzynski

Art Unit

1774

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 53,55 and 60-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53,55 and 61-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 53, 55 and 60-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "applied at a substantially thickness . . . to provide a surface onto which an image can be coated or onto which a preliminary transfer of an image can be made" renders the claim ambiguous. This phrase neither defined in the specification, nor does it possess a well-defined meaning in the art. What level of uniformity is required? Would a uniformity value exist which would *not* enable image coating or preliminary transfer? Is the degree of uniformity the same for both image coating and preliminary transfer functions?

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 53, 55 and 60-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi (JP 09-039090), either alone or in further view of Akiya. Applicant claims an article including a backing layer (which may comprise paper) having a basis weight of 90 g/m<sup>2</sup> to 110 g/m<sup>2</sup> and a coating of polymethylpentene material thereon, wherein the coating has a coating weight of about 10 g/m<sup>2</sup> to about 30 g/m<sup>2</sup>. Mitsubishi discloses a support comprising (1) a paper layer and (2) a layer of polymethylpentene resin thereon. *See* Abstract. The polymethylpentene

Art Unit: 1774

is applied uniformly, and possesses a coating weight value falling within the value range claimed by applicants. *See Mitsubishi*, p 814 (disclosing a coating weight of 3-70 g/m<sup>2</sup>). With regard to the claimed basis weight values of the paper backing layer, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Basis weight is notoriously well known in the art--it provides the desired level of stiffness to paper which, in turn, enables coatings to be placed thereon. *See Akiya* at col. 3, ll 1-53 and col. 6, ll 4-14. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215. To date, this burden has not been sustained.

5. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi, as applied to claims 53, 55 and 60-65, above, and further in view of Rimai (US 5300384). Rimai teaches that a layer of polyethylene may be placed on a recording medium on the side opposite the image-receptive layer in order to prevent the curling of the article. *See col. 4, ll 17-22*. It would have been obvious to one of ordinary skill in the art at the time of the invention to add a layer of polyethylene to the Mitsubishi receptive medium, motivated by the desire of preventing curl in the medium, as taught by Rimai on col. 4, ll 17-22.

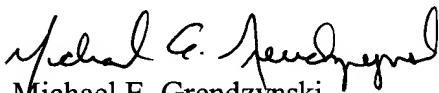
Art Unit: 1774

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



Michael E. Grendzynski

Assistant Examiner

November 26, 2002



BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300